



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,380	09/12/2003	Loc Nguyen	16222U-016600US	6693
20350	7590	07/01/2005	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			LEE, DIANE I	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/661,380

Applicant(s)

NGUYEN ET AL

Examiner

D. I. Lee

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 8, 10-14, 19-23, 27, 29-35, 40, 42-46, 51-55, 59 and 61-64 is/are rejected.
- 7) ☒ Claim(s) 4-7, 9, 15-18, 24-28, 36-39, 41, 47-50, 56-58 and 60 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3/15/04 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

1. Claims 1-64 are presented for examination.

Specification

2. The abstract of the disclosure is objected to because of the following(s):

- (a) Lines 4-5: "is disclosed. The system" should be deleted.

Correction is required. See MPEP § 608.01(b).

Claim Objections

3. Claims 1-2, 4, 7-10, 14-15, 18, 23-24, 28-29, 33-34, 36, 39-41, 46-47, 50-51, 55-56, and 60-61 are objected to because of the following informalities:

- (a) Re claim 1, line 9: It is vague and indefinite as to what is "it" in the claim.

Therefore, the phrase "it is determined" should be changed to --the control logic determines--;

- (b) Re claim 1, line 12: The phrase "it is determined" should be changed to --the control logic determines--;

- (c) Re claim 2, line 5: The phrase "it is determined" should be changed to --the control logic determines--;

- (d) Re claim 4, line 5: The phrase "it is determined" should be changed to --the control logic determines--;

- (e) Re claim 7, line 2: The phrase "it is determined" should be changed to --the control logic determines--;

- (f) Re claim 8, line 2: The phrase "it is determined" should be changed to --the control logic determines--; and

Art Unit: 2876

(g) Re claim 9, line 2: The phrase "it is determined" should be changed to --the control logic determines--.

Due to the numerous similar claim objections as set forth above, the Applicant's cooperation is requested in reviewing and correcting the claims to place the claims in better form.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3, 8, 10, 12-13, 14, 19, 21-23, 27, 29, 31-35, 40, 42, 44-46, 51, 53-55, 59, 61, 63-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoki et al. [US 5,691,525-referred as Aoki].

Note: Since claims do not explicitly point out the specific meanings of "image synchronization" or "image replacement" and "record image" the specific claimed phrases "image synchronization" or "image replacement" have been interpreted by the Examiner as --a data or fund transfer-- and the phrase "record image" has been interpreted by the Examiner as --storing data or fund--.

Re claims 1-2, 13-14, 22-23, 32-34, 45-46, 54-55, and 64: Aoki discloses a system for facilitating image management for portable devices, comprising:

a host (a host transaction network 2, 4, 13 for carrying out the account settlement between different bank computer or different financial database, see figure 1) configured to

Art Unit: 2876

maintain information relating to a first portable device (a first IC/smart card 1) and a second portable device (a second IC/smart card 3); and

an interface device (a settling terminal machine or a transaction terminal device 9) configured to communicate with a user, the host (the host transaction network 2, 4, 13 for carrying out the account settlement between different bank computer or different financial database) and the first and second portable devices 1, 3 (see figure 1);

the interface device having control logic (24: CPU), and wherein the interface device configured to: receive a synchronization/replacement request from the user (see col. 2, lines 28-37), in response to the synchronization/replacement request, determine whether the first portable device is valid for image synchronization (e.g., determining correct PIN, which determines the validity of the first IC card, such as determining whether the first card is issued by C bank 2 to an individual A having an account in the C bank or determining the first card having a recorded balance that is deducted from the account of the individual A, which preliminarily processed from the host, i.e., using information provided by the host); and if it is determined that the first portable device is valid for image synchronization, determine whether the second portable device is valid for image synchronization (i.e., verification of the money transaction of transferred to the second card preliminarily transmitted from the interface device, see col. 2, lines 45-55), and download an image of the first portable device to the second portable device (i.e., transferring the amount of money from the first card to the second card) if it is determined that the second portable device is valid for image synchronization.

Aoki does not explicitly teach the determining steps of the control logic 24 as recited the claims.

However, reviewing the block diagram of interface device shown in figure 3, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to

recognized that the control logic (CPU 24) obviously controls all processing logic of the interface device 9 in order to carry out the settlement between the accounts of the owner of the first IC card and the second IC card. Therefore, the control logic (CPU 24) of the interface device 9 obviously configured to the performed the claimed steps as recited the claims.

With respect the step of record an image of the first portable device, Aoki teaches that the memory 26 of the interface device 9 stores tentative information in the midst of processing and for storing the results of transaction. Since the transaction involves transferring the fund from one card to other via a system bus 25, it would have been obvious to an artisan of ordinary skill in the art at the time the invention is made to recognized that the step of record an image of the first portable device (the step of download the transfer fund from the first IC card to the memory 16 of the interface device 9 as a tentative information in the midst of processing or the results of transaction, such as transferred amount) in order to carry out the transferring operation logically from one card to another. Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to recognize that the interface device 9 obviously records the image of the first portable device (i.e., the deducting or deducted amount from the first IC card).

Re claims 3, 27, 35, and 59: wherein the image of the first portable device is retrieved from a database via the host (see col. 2, lines 18-27).

Re claims 8, 10, 19, 29, 40, 42, 51, and 61: wherein the second portable device is not valid for image replacement/synchronization if it is determined that the second portable device is not linked to the first portable device (since the data transfer is activated only when two IC cards 1, 3 are inserted into the settling terminal 9 (i.e., the second portable device is linked to the first portable device or second portable device is communicating to the first portable device, see the operational block diagram of interface device as shown in figure 3), the second portable device

Art Unit: 2876

is not valid for image replacement/synchronization (i.e., the second IC card is not physically valid for carrying out the fund/data transfer) when two IC cards are not linked (i.e., two IC cards are not communicating) (see col. 1, lines 53-58 and figure 3).

Re claims 12, 21, 31, 44, 53, and 63: wherein the system is implemented using software, hardware or a combination of both (see col. 3, lines 58-59 and figures 1-3).

6. Claims 11, 20, 30, 43, 52, and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoki in view of Combaluzier [US 2002/0107797 A1]. The teachings of Aoki have been discussed above.

Aoki does not teach the first and second portable device containing reward information relating to a loyalty program.

Combaluzier discloses a system facilitating a fund transfer from one portable device (a first smart card) to another portable device (a second smart card) and wherein the first and second portable device containing reward information relating to a loyalty program (see the abstract and paragraph 0006 for example).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the first and second portable device containing reward information relating to a loyalty program in the fund transferring system of Aoki in order to provide a reward related transaction by incorporating a loyalty program in the data/fund transfer. Such modification would have provide a user to use the reward information relating to a loyalty program when making a purchase by transferring the reward information relating to a loyalty program from one card to another card.

Allowable Subject Matter

7. Claims 4-7, 9, 15-17, 18, 24-26, 28, 23-39, 41, 47-50, 46-58, and 60 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter: the prior art of the record fails to teach or fairly suggest the specifics of the control logic concatenating the additional information with first portable device upon determination that the additional information is included in the second portable device and not in the first portable device and identifying the portable device not valid for image synchronization/placement if it is determined that an authorized number of image synchronization/placement have been performed, as set forth in the claims.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Diehl [US 5,162,638], Mori [US 6,138,907], Mori [US 5,854,581], and [US 5,774,546] discloses a fund transfer system configured to transfer fund/data from one card to another.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. I. Lee whose telephone number is (571) 272-2399. The examiner can normally be reached on Monday through Thursday from 5:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2876

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



D. I. Lee
Primary Examiner
Art Unit 2876